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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/358,529	07/22/1999	FUJIO NOGUCHI	450100-02002	1683

20999 7590 01/27/2005

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EXAMINER
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GENCO, BRIAN C

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/358,529	<b>Applicant(s)</b> NOGUCHI ET AL.	
	<b>Examiner</b> Brian C Genco	<b>Art Unit</b> 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Examination of the instant invention is now being conducted by Brian Genco.

Applicant's amendment filed September 15, 2004 has been fully considered but is not deemed persuasive.

Applicant argues that Wakui does not disclose "control means for causing said first recording mode to be automatically set when the loading of said first recording medium is detected".

In response, Examiner notes that the disclosure of Wakui shows an interrupt routine in Fig. 16 that occurs upon detecting that the memory card, i.e., the first recording medium, is loaded by said detection means (e.g., column 19, lines 17-22). As cited in the previous Office Action, the result of this interrupt routine is that the recording mode is changed from the flash memory record mode to a memory card record mode. While Wakui disclose the additional step of detecting the capacity of the memory card before switching the recording mode this does not preclude Wakui from meeting the claim limitations of claims 2 and 3. In particular, Examiner notes that claims 2 and 3 are claims "comprising" a group of limitations. Therefore, since the claim is written using open-ended language, so long as the claimed limitations are met any additional steps or limitations can be taught by the prior art relied upon and still meet the claim limitations.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Wakui, U.S. Patent 5,648,816.

Regarding claim 2, Wakui teaches an image capturing apparatus (still video camera 1) comprising first operation means (IC memory card control circuit 15) for recording an image-capturing signal on a first recording medium (IC memory card 31) in accordance with a first recording mode (memory card record mode) (col. 5, lines 43-46, 53-56, Fig. 4), second operation means (flash memory control circuit 19) for recording an image-capturing signal on a second recording medium (image flash memory 20) in accordance with a second recording mode (flash memory record mode) (col. 6, lines 32-38, Fig. 5), and detection means (memory card detecting circuit 16) for detecting the loading of said first recording medium (IC memory card 31) (col. 5, lines 64-67). Wakui also teaches that when the IC memory card is loaded, the recording of image data in the flash memory is stopped, the memory card record mode is set, and recording in the IC memory card begins (col. 19, lines 48-53, Fig. 16), which reads on an

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automatic setting of the first recording mode when the first recording medium is detected. The control means for setting the recording mode is inherently taught.

Regarding claim 3, Wakui teaches an image capturing apparatus (still video camera 1) that can switch between a first operation mode (memory card record mode) for recording an image-capturing signal on a first recording medium (IC memory card 31) and a second operation mode (flash memory record mode) for recording an image-capturing signal on a second recording medium (image flash memory 20) (col. 8, lines 24-41, 54-60), and detection means (memory card detecting circuit 16) for detecting the loading of said first recording medium (IC memory card 31) (col. 5, lines 64-67). The control means for switching the operation mode is inherently taught. Wakui also teaches that when the IC memory card is loaded, the recording of image data in the flash memory is stopped, the memory card record mode is set, and recording in the IC memory card begins (col. 19, lines 48-53, Fig. 16), which reads on an automatic setting of the first recording mode when the first recording medium is detected.

Claims 2-4 are rejected under 35 U.S.C. 102(e) as being anticipated by (USPN 6,184,922 to Saito et al.).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

In regards to claim 2 Saito discloses an image capturing apparatus comprising:

first operation means for recording an image-capturing signal on a first recording medium in accordance with a first recording mode (e.g., recording a still image when the expansion unit 107 is a still image-specific expansion unit; Fig. 9B; column 16, lines 19-31);

second operation means for recording an image-capturing signal on a second recording medium in accordance with a second recording mode (e.g., capturing motion picture data when expansion unit 107 is a motion picture-specific expansion; column 16, lines 31-37);

detection means for detecting the loading of said first recording medium (e.g., base on the disclosure there is inherently a means for detecting which type of expansion unit is attached so as to enable the appropriate recording mode); and

control means for causing said first recording mode to be automatically set when the loading of said first recording medium is detected by said detection means (e.g., this is also inherent to the disclosure since the mode is automatically switched depending on what type of expansion unit is attached).

In regards to claim 3 see Examiner's notes on the rejection of claim 2.

In regard to claim 4 see Examiner's notes on the rejection of claim 2. Note that the still image-specific expansion unit captures still images and the motion image-specific expansion unit captures moving pictures. Further note that the images are recorded on their respective expansion units.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 6,184,922 to Saito et al.).

In regards to claim 5 see Examiner's notes on the rejection of claim 2. Note that the still image-specific expansion unit is equipped with a PC card recording medium (e.g., column 16, lines 28-31). Also note that the motion picture-specific expansion unit is equipped with a DVD recording medium. Examiner takes Official Notice that one skilled in the art would clearly recognize the equivalence of a DVD recording medium and a tape recording medium for their

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use in recording motion picture data and the selection of any of these known equivalents to be well within the level of one skilled in the art.

In regards to claim 6 see Examiner's notes on the rejection of claim 5.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian C. Genco who can be reached by phone at 703-305-7881 or by fax at 703-746-8325. The examiner can normally be reached on Monday thru Friday 8:30am to 4:30 pm.



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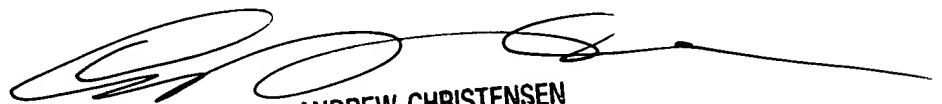
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-308-4357.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian C Genco  
Examiner  
Art Unit 2615

January 20, 2005



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